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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/630,752
Filing Date: August 02, 2000
Appellant(s): BAUM ET AL.

MAILED

SEP 06 2007

GROUP 3600

Xin Wen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/06/2007 appealing from the Office action mailed 07/26/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

6,369,908	FREY	04-2002
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5,170,466	ROGAN	12-1992
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Ofoto.com Launches Innovative Photo Finishing Service, PR Newswire, New York,
December 13, 1999

(9) Grounds of Rejection

A copy of the final office action mailed 07/26/2005 is provided below:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5, 8, 9, 17, 18-22, 24, 26, 33, 44, 45, 48, 50, and 56-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey (US 6,369,908) in view of Ofoto and further in view of Rogan et al. (5,170,466) ("Rogan").

Regarding claims 1, 3, 17, 57, 59, 60 and 63, Frey discloses a method of collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider, wherein the kiosk includes a computer, a data storage device and an interface for capturing digital images, wherein the data storage device includes computer readable media for storing information representative of the digital images (col. 2, lines 41-56; and col. 3, lines 19-26), the method comprising: accepting image information from a customer into the interface of the kiosk; accepting user-identifier information into the computer, the user-identifier information corresponding to the customer (col. 6, lines 9-14);

accepting order information into the computer, the order information specifying a service to be provided relative to the image information (Abstract, Fig. 2-5; and col. 4, lines 4-18); and

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storing into a local storage connected to the computer, a digital representation of the image information and associated user identifier information and order information for each of a plurality of different customers into a data structure (col. 5, lines 19-30; and col. 5, lines 35-40).

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk; and storing the data structure in the image-processing provider*. However, Rogan teaches a high capacity storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

Assuming Frey and Rogan do not expressly teach *sending the data structure to the image-processing provider via a communication medium*, Ofoto overcomes this ostensible deficiency. Ofoto discloses an online finishing service wherein users are

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permitted to submit digital images to a developer over a communications network (pp. 1-2). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey and Rogan to include the teachings of Ofoto in that *sending the data structure to the image-processing provider via a communication medium* would enable the Frey/Rogan method to offer a wider range of services than just photographic emails.

Regarding claim 2, Frey discloses removing the data structure from the local storage after the data structure has been sent to the image-processing provider (Abstract).

Regarding claim 5, Frey discloses displaying to the customer at least one image from the image information (col. 3, lines 47-49).

Regarding claim 8, Frey discloses the method of claim 1, wherein the order information further includes a modification to be made to at least one image from the image information (col. 4, lines 5-16).

Regarding claim 18, Frey discloses a kiosk for accepting image-processing orders from a customer for processing at a remote image-processing provider, the kiosk comprising:

a controller (col. 2, lines 40-56);

a storage device operatively coupled to the controller (col. 5, lines 9-19);

an image input device operatively coupled to the controller, wherein the controller transfers digital image information from the image input device to the storage device (Abstract; col. 2, lines 40-56; and col. 3, lines 42-46);

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a user input device operatively coupled to the controller to produce user identifier information and order information based on input from the customer, wherein the order information specifies a service to be provided relative to the image information, and wherein the controller associates the user-identifier information and the order information with the digital image information (Abstract; col. 4, lines 4-17; and col. 5, lines 35-40); and

a data transmission interface operatively coupled to the controller and to a communication medium, wherein the controller sends the digital image information and its associated user-identifier information and order information to the image-processing provider via a communication medium (col. 2, lines 42-56; col. 4, lines 4-16; col. 5, lines 34-40 and 47-49).

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, the controller sends data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; and in response to receipt of the sent data structure address information at the image-processing provider, the controller sends a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk.* However, Rogan teaches a high capacity storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary

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skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

Regarding claims 19, 20 and 22, Frey discloses a kiosk according to claim 18, further comprising a credit card information input device operatively coupled to the controller (col. 3, lines 20-26) and a display (col. 3, lines 47-49).

Regarding claim 21, Frey discloses the kiosk of claim 20, wherein the user input device further accepts input from the customer to specify a modification to be made to at least one image from the image information, and wherein the display provides a visual indication of the image as modified by the modification (col. 4, lines 4-30).

Regarding claim 26, Frey discloses the kiosk of claim 18, wherein the image input device includes a digital camera interface that transfers image data directly from a digital camera (Abstract).

Regarding claim 33, Frey teaches a remote film processing system for obtaining digital image data from a customer and remotely processing the image prints, the system comprising:

- a network (Abstract);

- a kiosk coupled to the network (Id.); and

- means for obtaining the digital image data into the kiosk and locally storing the data, and for transferring the data to a repository system interconnected to the kiosk by the network (Abstract; col. 1, lines 54-59);

means, in response to receipt of a first poll request at the kiosk and if a data structure is available,¹ for sending data structure address information corresponding to available data structure from the kiosk via the communications medium; and

in response to receipt of the sent data structure address information at the image processing provider, sending a data structure fetch request across the communications medium to the kiosk (Id.).

Frey does not teach means, in response to receipt of a first poll request at the kiosk and if a data structure is available, for sending data structure address information corresponding to available data structure from the kiosk via the communication medium.

The Examiner notes, the "if" step is a conditional limitation and is given little patentable weight. Methods are composed of actions, when you perform the actions of a method and do not select one of the alternatives or "if" steps, you are not performing any action under those alternatives.

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, the controller sends data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; and in response to receipt of the sent data structure address information at the image-processing provider, the controller sends a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk*. However, Rogan teaches a high capacity storage and retrieval system for image processing

¹ Note the limitations following the conditional language "if a data structure is available" are not

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wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

Assuming Frey and Rogan do not expressly teach *sending the data structure to the image-processing provider via a communication medium*, Ofoto overcomes this ostensible deficiency. Ofoto discloses an online finishing service wherein users are permitted to submit digital images to a developer over a communications network (pp. 1-2). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey and Rogan to include the teachings of Ofoto in that *sending the data structure to the image-processing provider via a communication medium* would enable the Frey/Rogan method to offer a wider range of services than just photographic emails.

Regarding claim 44, Frey discloses An automated kiosk for accepting image-processing orders from a customer for processing at a remote image-processing provider, the kiosk comprising:
a controller (col. 2, lines 41-56);

a storage device operatively coupled to the controller (col. 3, lines 19-26);

necessarily read into the claim. This results from the fact that these limitations are not appurtenant to the claim in instances where the stated condition is not satisfied.

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a plurality of image input devices operatively coupled to the controller, each input device accepting a different type of image information, wherein the controller transfers digital image information from the image input devices to the storage device (Abstract; and col. 3, lines 43-47);

a credit-card reader operatively coupled to the controller, the reader operable to read data of a credit card (col. 6, lines 9-15);

a user input device operatively coupled to the controller to produce user identifier information and order information based on input from the customer, wherein the order information specifies a service to be provided relative to the image information, and wherein the controller associates the user-identifier information and the order information with the digital image information (col. 4, lines 5-30; and col. 5, lines 35-40);

a display that displays the digital image information, user-identifier information, and order information (col. 3, lines 47-67); and

a data transmission interface operatively coupled to the controller and to a communication medium, wherein the controller sends the digital image information and its associated user-identifier information and order information to the image-processing provider via a communication medium (col. 5, lines 44-57).

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, the controller sends data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; and in response to receipt of the sent data structure address information at the image-*

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processing provider, the controller sends a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk. However, Rogan teaches a high capacity storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

Regarding claims 45 and 56, Frey discloses a method of collecting images from a plurality of customers into an image upload kiosk, and transferring images from the kiosk to an image-processing provider, wherein a data storage device and an input interface for capturing digital images, wherein the data storage device includes computer readable media for storing information representative of the digital images, the method comprising:

storing image and associated user-identification and order information from each of the plurality of customers into the storage device of the kiosk (Abstract; and col. 5, lines 10-19);

connecting the kiosk to a telecommunications channel (Abstract; and col. 5, lines 44-57); and

transferring the information over the telecommunications channel from the kiosk to the image-processing provider, wherein transferring the information over the

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communications channel includes storing the information to a storage device at the image-processing provider (Id.).

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; and in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk.* However, Rogan teaches a high capacity storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

Regarding claims 48 and 50, Frey discloses a telecommunications network selected from the group consisting of: a telephone network; and a cable network (col. 5, lines 54-57).

Regarding claim 58, Frey teaches an event detector comprising a timer wherein the event is a time-based event.

Regarding claim 61, Frey discloses a user interface comprising an image display that displays digital images to the customer (col. 3, lines 44-67).

Regarding claim 62, Frey discloses a digital data interface for receiving digital image data, and means, coupled to the interface, for storing and later uploading the digital image data across a communications medium (Abstract).

Regarding claim 62, Frey teaches a digital image upload apparatus comprising:
a digital data interface for receiving digital image data (Fig. 1; and col. 2, lines 30-33), and means, coupled to the interface, for storing and later uploading the digital image data across a communications medium (Abstract; Fig. 5, chars. 241-245; and col. 5, lines 10-29); means, in response to receipt of a first poll request at the kiosk and if a data structure is available,² for sending data structure address information corresponding to available data structure from the kiosk via the communications medium; and means in response to receipt of the sent data structure address information at the image processing provider, sending a data structure fetch request across the communications medium to the kiosk (Id.).

Frey does not teach means, in response to receipt of a first poll request at the kiosk and if a data structure is available, for sending data structure address information corresponding to available data structure from the kiosk via the communication medium.

The Examiner notes, the "if" step is a conditional limitation and is given little patentable weight. Methods are composed of actions, when you perform the actions of

² See fn. 1.

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a method and do not select one of the alternatives or "if" steps, you are not performing any action under those alternatives.

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, the controller sends data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; and in response to receipt of the sent data structure address information at the image-processing provider, the controller sends a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk*. However, Rogan teaches a high capacity storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

Assuming Frey and Rogan do not expressly teach *sending the data structure to the image-processing provider via a communication medium*, Ofoto overcomes this ostensible deficiency. Ofoto discloses an online finishing service wherein users are permitted to submit digital images to a developer over a communications network (pp. 1-2). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey and Rogan to include the teachings of Ofoto in that

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sending the data structure to the image-processing provider via a communication medium would enable the Frey/Rogan method to offer a wider range of services than just photographic emails.

Regarding claims 63, Frey discloses a method of collecting images and order information by an image-processing provider from at least one image kiosk, wherein the image kiosk includes a computer, a data storage device and an interface for capturing digital images, wherein the data storage device includes computer readable media for storing information representative of the digital images (Abstract), the method comprising:

accepting image information from a customer into the interface of the kiosk;
storing the image information into a local storage (Abstract; col. 3, lines 44-67);

sending inquiring signal from the image-processing provider to the kiosk; replying the inquiring signal with an image use signal (col. 6, lines 12-40); and

transferring the image data to the image-processing provider via a communication medium (col. 5, lines 44-57).

Frey does not expressly teach *in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; and in response to receipt of the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk.* However, Rogan teaches a high capacity

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storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic. be transmitted more quickly by transmitting images during periods of low network traffic.

Regarding claim 64, Frey discloses removing the image information from the local storage after the image-data transfer (Abstract; and col. 5, lines 20-25).

Regarding claims 9 and 24, Frey, Rogan and Ofoto teach all the limitations discussed under claims 1 and 18. Frey and Rogan do not expressly teach receiving order information comprising a plurality of delivery addresses to which at least one print from the image information is to be delivered. However, Ofoto teaches an online service for developing digital images wherein developed prints are delivered to a customer-designated address. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to combine the teachings of Frey and Rogan and Ofoto. Modifying Frey and Rogan to include order information comprising a plurality of delivery addresses to which at least one print from the image information is to be delivered provide users with the ability to order professional-grade prints of pictures taken by the kiosk.

Claims 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey in view of Ofoto.

Regarding claims 34, 35, 36, 40 and 41, Frey discloses a computer-implemented method of business comprising:

accepting image information at a first business location (Abstract);

accepting user-identifier information and order information associated with the image information at the first business location (Abstract; col. 3, lines 20-25; col. 4, lines 5-30; and col. 6, lines 9-15);

processing and digitally storing a plurality of images from the image information at the first business location (col. 3, lines 19-26 and 43-67);

accepting payment at the first business location (col. 6, lines 9-15);

transferring the digital stored images to a second business location across a communications medium (Abstract; and col. 5, lines 44-57); and

in response to receipt of a first poll request and if data structure is available,³ sending data structure address information corresponding to the available data structure via the communications medium; and in response to receipt of the sent data structure address information at the image processing provider, sending a data structure fetch request across the communications medium.

Frey does not expressly teach storing the digital images at the second business location, processing prints of the stored images at the second business location and delivering the processed prints to a customer. However, Ofoto teaches an online

³ See fn. 1.

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service for developing digital photos including the steps of storing a plurality of customer images at the service provider Website, developing at least one customer image and delivering the at least one developed image to a customer. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include storing the digital images at the second business location, processing prints of the stored images at the second business location and delivering the processed prints to a customer as taught by Ofoto. This combination would allow users to order prints from a professional developing service thereby allowing the kiosk to offer a wide range quality photographic products.

Regarding claim 37, Frey discloses accepting input from the customer specifying a modification to be made to at least one image and displaying a modified image resulting from the modification (col. 4, lines 5-32).

Regarding claims 38 and 39, Frey teaches accepting a credit-card payment from the customer into the kiosk (col. 6, lines 9-15).

Regarding claim 42, Frey teaches all the limitations discussed under claim 34. Frey further teaches displaying captured images to the user at the first location and accepting input from the customer specifying a modification to be made to at least one image, and displaying a modified image resulting from the modification, and accepting a payment from the customer into the kiosk (col. 4, lines 5-32; and col. 6, lines 9-15). Frey does not expressly teach accepting input from a customer specifying at least one delivery address for processed prints. However, Ofoto teaches an online developing service that delivers prints of pictures taken by a digital camera. At the time of

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Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify Frey to include accepting input from a customer specifying at least one delivery address for processed prints. This modification would permit Frey's photographic kiosk to offer customers a wide range of high quality photography products.

Regarding claim 43, Frey discloses transferring a data structure that includes image data of a plurality of customers across an Internet connection within a single Internet session (col. 5, lines 34-39).

Claims 4, 6, 7, 10-16, 23, 25, 27-32, 46, 47, 49 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey in view of Rogan, Ofoto and Official Notice.

Regarding claim 4, Frey, Rogan and the PR Newswire article disclose the limitations discussed under claim 1. Frey, Rogan and the PR Newswire article do not expressly disclose accepting credit-card payment, and storing into the local storage connected to the computer, a digital representation of the credit-card information. However, the Examiner takes Official Notice that storing credit card payment information, as by an electronic wallet, for expediting e-commerce transactions is old and well known. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frey, Rogan and the PR Newswire article to include accepting credit-card payment, and storing into the local storage connected to the computer, a digital representation of the credit-card information. Implementing this combination would allow users to pay for their orders automatically.

Regarding claim 6, Frey discloses displaying to the customer a plurality of thumbnail images from the image information (col. 3, lines 49-67).

Regarding claim 7, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 1. Frey, Rogan and the PR Newswire article do not expressly disclose printing a receipt describing the order and including a printout of a plurality of thumbnail images from the image information. However, the Examiner takes Official Notice providing a printed receipt in connection with a photographic kiosk is old and well known in the art. Printing a series of pictures, as by a photo booth, is similarly old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include printing a receipt describing the order and including a printout of a plurality of thumbnail images from the image information. Providing Frey, Rogan and the PR Newswire article with a means for printing a receipt would provide users with a transaction record. Also, including a printout of a plurality of thumbnail images from the image information would provide users with a tangible copy of their images. This would permit users to share their images with others immediately after using the kiosk.

Regarding claims 10 and 25, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claims 1 and 18. Frey, Rogan and the PR Newswire article do not expressly disclose accepting image information by optically scanning film images to generate a digital representation of the film images. However, the Examiner takes Official Notice that scanning photographs to create an electronic image for transmitting via e-mail is old and well known in the art. Therefore, at the time of

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Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Frey, Rogan and the PR Newswire article to include accepting image information by optically scanning film images to generate a digital representation of the film images. This would enable the photographic kiosk to process a wider range of photographs since users would not be limited to processing images that are captured in the kiosk environment.

Regarding claims 11 and 13, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 1. Frey, Rogan and the PR Newswire article do not expressly disclose accepting image information by transferring image data directly from a digital image storage medium. However, the Examiner takes Official Notice that storing image data on a portable storage medium, such as a floppy disk, is old and well known in the art. Note Frey suggests capturing image information from a portable storage medium in that Frey discloses a disk drive for receiving a portable storage medium (see col. 5, lines 22-24; and Fig. 1, char. 23). Modifying Frey, Rogan and the PR Newswire article to accept image information from a digital storage medium would enable users to transmit a wider range of images since images would not have to be captured in the kiosk environment.

Regarding claims 12, 14 and 15, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 11. Frey does not expressly disclose accepting image information from a memory stick, over a USB port or by a wireless receiver. However, these limitations are old and well known in the art and their combination with the present invention does not provide a critical advantage over the

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method taught by Frey. Therefore, it would have been obvious to one of ordinary skill in the art, to modify Frey, Rogan and the PR Newswire article to accept image information from a memory stick, over a USB port or by a wireless receiver.

Regarding claim 16, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 1. Frey, Rogan and the PR Newswire article do not expressly disclose the method of claim 1, wherein accepting image information includes accepting undeveloped film into the kiosk, processing the undeveloped film to generate developed film, optically scanning the developed film and generating at least one digital representation of the developed film. However, the Examiner takes Official Notice that developing film in a kiosk environment, as by a photo booth, is old and well known. Optically scanning photographs to prepare a digital image for transmission by e-mail is also old and well known in the art. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frey, Rogan and the PR Newswire article to include accepting undeveloped film into the kiosk, processing the undeveloped film to generate developed film, optically scanning the developed film, and generating at least one digital representation of the developed film developed film. This combination would allow users to process an unlimited range of pictures since images would not have to be captured in an austere kiosk environment.

Regarding claim 23, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 18. Frey, Rogan and the PR Newswire article do not expressly disclose a printer that prints a receipt that describes the order and includes a printout of the plurality of thumbnail images from the image information. However, the

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Examiner takes Official Notice providing a printed receipt in connection with a photographic kiosk is old and well known in the art. Printing a series of pictures, as by a photo booth, is similarly old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Frey to include printing a receipt describing the order and including a printout of a plurality of thumbnail images from the image information. Providing a means for printing a receipt would provide users with a transaction record. Also, including a printout of a plurality of thumbnail images from the image information would provide users with a tangible copy of their images. This would permit users to share their images with others immediately after using the kiosk.

Regarding claim 27, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 18. Frey, Rogan and the PR Newswire article do not expressly disclose an image input device comprising a storage medium interface that transfers image data directly from a storage medium. However, the Examiner takes Official Notice that storing image data on a portable storage medium, such as a floppy disk, is old and well known in the art. Note Frey suggests capturing image information from a portable storage medium in that Frey discloses a disk drive for receiving a portable storage medium (see col. 5, lines 22-24; and Fig. 1, char. 23). Modifying Frey to accept image information from a digital storage medium would enable users to transmit a wider range of images since images would not have to be captured in the kiosk environment.

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Regarding claims 28-31, Frey, Rogan and the PR Newswire article disclose all the limitations discussed under claim 27. Frey, Rogan and the PR Newswire article do not expressly disclose a storage medium interface selected from the group consisting of: a memory stick port; a rotatable storage disk; a USB port; and a wireless receiver port. However, these storage mediums are old and well known in the art. Moreover, modifying Frey to include a memory stick port, a rotatable storage disk, a USB port or a wireless receiver port would perform the same function in a similar manner. Therefore, modifying Frey, Rogan and the PR Newswire article to include a storage medium interface selected from the group consisting of a memory stick port, a rotatable storage disk, a USB port, and a wireless receiver port would have been obvious to one of ordinary skill in the art at the time of Applicants' invention.

Regarding claim 32, Frey, Rogan and Ofoto disclose all the limitations discussed under claim 18. Fr a storage medium interface selected from the group consisting of: a memory stick port; a rotatable storage disk; a USB port; and a wireless receiver port do not expressly disclose an image input device comprising: a mechanical port that accepts undeveloped film into the kiosk; a film processor coupled to the mechanical port that processes the undeveloped film to generate developed film in the kiosk; and an optical scanner that scans the developed film and generates at least one digital representation of the developed film. However, the Examiner takes Official Notice that developing film in a kiosk environment, as by a photo booth, is old and well known. Optically scanning photographs to prepare a digital image for transmission by e-mail is also old and well known in the art. At the time of Applicant's invention, it would have

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been obvious to one of ordinary skill in the art, to modify Frey, Rogan and the PR Newswire article to include an image input device comprising: a mechanical port that accepts undeveloped film into the kiosk; a film processor coupled to the mechanical port that processes the undeveloped film to generate developed film in the kiosk; and an optical scanner that scans the developed film and generates at least one digital representation of the developed film. This combination would allow users to process an unlimited range of pictures since images would not have to be captured in an austere kiosk environment.

Regarding claims 46, 47, 49 and 51, Frey, Rogan and the PR Newswire article teach all the limitations discussed under claim 48. Frey, Rogan and the PR Newswire article do not expressly teach storing image and associated user-identification and order information by removing a data-storage medium from a digital imaging system, and inserting the data-storage medium in the receptacle. However, the Examiner takes Official Notice that storing image data on a portable storage medium, such as a floppy disk, is old and well known. Frey suggests modifying its method to include storing image information on a removable storage medium in that Frey discloses a receptacle for a portable storage medium (see col. 5, lines 22-24; and Fig. 1, char. 23). Thus, it would have been obvious to one of ordinary skill in the art, to modify Frey, Rogan and the PR Newswire article to include the steps of saving image information on a removable storage medium, and uploading the image information to the kiosk in order to give users the ability to process a wider range of pictures.

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Regarding claim 51, Frey further teaches establishing a connection through the cable network between the image upload device and the image-processing provider (col. 5, lines 54-57).

Regarding claims 52-55, Frey, Rogan and the PR Newswire article teach all the limitations discussed under claim 46. Frey, Rogan and the PR Newswire article do not expressly disclose downloading image information and user information from the digital imaging device by a cradle interface. Frey also lacks an express teaching of recharging the digital image system through the cradle interface. However, the Examiner takes Official Notice that downloading information from a data processor through a cradle, wherein the cradle also recharges the data processing device, is old and well known in the art. Therefore, at the time of Frey, Rogan and the PR Newswire article to include downloading image information and user information from the digital imaging device by a cradle interface. This combination would allow users to quickly download digital images as well as convey identification and/or payment information.

(10) Response to Argument

The Appellant argues (page 11 of Appeal Brief) that neither Frey, Ofoto, nor Rogan disclose storing into a local storage connected to the computer, a digital representative of the image information and associated user identifier information and order information for each of a plurality of different customers into a data structure.

The Examiner notes, Frey discloses a system wherein the user was provided the option of saving files such as audio files, text files, and video files onto a removable storage device (i.e. local storage) connected to the computer (i.e., kiosk) (Frey: column 5, lines 30-42).

Frey later discloses a system wherein a CPU populates a database (i.e., data structure) with multiple files from multiple users. Furthermore, the CPU, at predetermined, specific times of day, initiates a connection with the Internet wherein the CPU transmits the saved files from within the database to email address associated with various customers. After the transmission of files is completed, the CPU disconnects from the Internet and de-activates the modem and telephone line. The CPU saves the sent files and associated addresses in the database. This information is transferred from the photo kiosk during maintenance procedures and may be used for marketing of additional products (Frey: column 5, lines 42-57).

The Examiner further notes, even though Frey discloses the storing of various types of information into a local storage connected to the computer and a data structure, the type of information stored, can be construed as nonfunctional descriptive

information. The storing step, and subsequent steps, would be performed the same regardless of the information type. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

The Appellant argues (page 12 of Appeal Brief) that the user's removable media in Frey contains information for only one user.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims as written do not require storing the order information for each of a plurality of different customers into the local storage, the claims require merely storing order information for each of a plurality of different customers into any data structure. This data structure does not need to be removable as argued by the Appellant.

The Appellant merely states (page 13 of Appeal Brief) that Rogan does not disclose the claimed specifics, namely in response to receipt of a first poll request at the kiosk and upon detecting the availability of the data structure, sending data structure address information corresponding to the available data structure from the kiosk to the image processing provider via the communications medium; in response to receipt of

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the sent data structure address information at the image-processing provider, sending a data-structure-fetch request across the communications medium from the image-processing provider to the kiosk; and storing the data structure in the image-processing provider.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the Rogan reference.

Furthermore, Rogan teaches a high capacity storage and retrieval system for image processing wherein an image packet is transmitted from a modular data storage to an image processing unit in response to a request to retrieve the image packet (col. 7, lines 26-29). The disk controller board as discussed in Rogan receives an image packet and prepares it for transmittal to a disk drive location. Data is then transferred from a disk controller to a disk. The image packer is stored on the disk until the SRM module receives a request to retrieve the selected image packet or group of packets. Image packets are retrieved through a read and transfer of the packet data (Rogan: column 7, lines 27-36).

The Appellant argues (page 13 of Appeal Brief) that merely because the references relied upon teach all aspects of the claimed invention is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the reference.

The Examiner notes, KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396. The rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictive results to one of ordinary skill in the art at the time of invention. With reference to the instant application, it would have been obvious to one of ordinary skill in the art, to modify Frey to include the teachings of Rogan. This combination would enable Frey to provide a batch processing function whereby image data could be transmitted more quickly by transmitting images during periods of low network traffic.

The Appellant notes, that they could not locate any discussion of sending a data structure having a digital representation of the image information and associated user identifier information and order information for each of a plurality of different customers within the Ofoto reference.

The Examiner notes, Ofoto was relied on merely to teach sending a data structure to the image-processing provider via a communication medium. Nonetheless, Ofoto clearly discloses an online finishing service wherein users are permitted to submit digital images to a developer over a communications network (Ofoto: page 1-2).

The Examiner further notes, even though Ofoto discloses the limitation as set forth above, the contents of said data structure can be construed as nonfunctional descriptive information. The sending step, and subsequent steps, would be performed the same regardless of the contents of said data structure. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

The Appellant argues that there is not any motivation to modify the references so as to provide transferring images from the kiosk to an image-processing provider as presently claimed.

The Examiner notes, *KSR* forecloses Appellant's arguments. The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396. Within the instant application, it would have been obvious to one of ordinary skill in the art, to modify Frey and Rogan to include the teachings of Ofoto in that sending the data structure to the image-processing provider via a communication medium would enable the Frey/Rogan method to offer a wider range of services than just photographic emails.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

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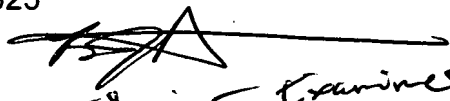
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